

## **REMARKS**

### **I. Introduction**

Claims 1-17, 19-23, 25-74, and 77-98 are pending in the present application. Applicants gratefully acknowledge the Examiner's indication that claims 20-23, 25, 52-55, and 62-69 are allowed. In view of the following remarks, it is respectfully submitted that claims 1-17, 19, 26-61, 70-74, and 77-98 are also allowable. Reconsideration of the present application is requested.

### **II. Rejection of Claims 1-3, 5-8, 10, 13-15, 17, 26-27, 29, 31-33, 35-38, 40, 43-45, 47, 49, 51, 59-61, 70-72, 74, 77-85, 87-90, and 92 under 35 U.S.C. § 103(a)**

Claims 1-3, 5-8, 10, 13-15, 17, 26-27, 29, 31-33, 35-38, 40, 43-45, 47, 49, 51, 59-61, 70-72, 74, 77-85, 87-90, and 92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,216,141 to Straub et al. ("Straub et al.") in view of PCT Patent No. WO 00/48069 to Cho Jun Ho et al. ("Cho Jun Ho et al."). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Examiner states in the Office Action dated 6 April 2005 at page 3 that "Displaying the object in response to the request by overlay is taught by Straub can be seen in Fig. 5" (emphasis in original). Applicants respectfully submit that the display of the viewer and channel bar taught by Straub et al. and shown in FIG. 5 is not the same as the use of overlaying and an overlay plane in the window of a software application.

Claim 1 recites "displaying the object . . . by *overlaying* the created overlay plane *in the window* . . . ." Claims 17, 31, 47, 77, 83, 84 and 85 include similar language. These independent claims clearly state that the *overlaying* of an object occurs *in the window*—not merely that an object is included or integrated in a window.

Unlike the present application, Straub et al. do not disclose overlaying an object in a window of a software application as in the present application but instead disclose including an HTML viewer in the desktop window, where the HTML viewer displays an HTML document. This is similar to any conventional means of including an object in a document and does not involve *overlaying* as described in the present application. In particular, Straub et al. describe at col. 3, lines 24-25 “one or more documents are then integrated into the desktop window on the client computer”. This is further described at col. 8, lines 10-14, i.e., “[t]he viewer 140 and channel bar 144 are integrated into the desktop window meaning they are in the same window as the desktop window. Thus, the document is displayed on the desktop window without opening a separate window.” (emphasis added). Straub et al. teach including (“integrating”) a document viewer in the window to display information and do not teach the *overlaying* of an object with the window as disclosed in the present application which is different than just *including* an object in a window. Beyond this basic description, Straub et al. do not teach or even hint at overlaying and provide no further details. For this reason, Straub et al. do not disclose this feature of the claims.

In addition, Examiner states in the Office Action dated 6 April 2005 at pages 2 and 3 that Straub et al. disclose the “Receiving a request for the object to be displayed in the window, the request being initiated by a behavior of a user viewing the window” as part of a “method for overlaying an object in a window of a software application” as “the technique of three overlapping windows 116, 118 and 120 overlay the desktop window 104 in front to back order. Each window represents a separate application, file or document. Window 120 is the front most window and as such is the window which accept [sic] user input (see col. 7, lines 57-61 and see Fig. 4)” (emphasis in the original). Applicants respectfully submit that the use of separate windows in Fig. 4 and the cited passages is not the same as the use of an overlay plane or overlaying *in the window* of a software application; i.e., a additional window is not initiated.

In accordance with the present invention, the overlaying of content in the window is provided either directly (e.g., through direct

compositing as discussed in the Specification on page 6, lines 15-29) or by using an intrinsic layering feature of the window-based application software—not by using additional windows.

Cho Chun Ho et al. do not cure the above-described deficiencies of Straub et al. Moreover, the Examiner relies on Cho Jun Ho et al. for disclosing the feature "the object is displayed in a manner that is independent of a movement of a pointing device." Respectfully, it would not be obvious to combine the disclosure of Cho Jun Ho et al. with the disclosure of Straub et al., at least in the manner suggested by the Examiner. In particular, the Examiner apparently relies on Cho Jun Ho et al. description of "pop-ups" as disclosing the display of an objected that is independent of a movement of a pointing device. However, this display of "pop-ups" has nothing to do with the integration of a channel bar into a window (as described by Straub et al.).

Applicants respectfully request the withdrawal of this objection for at least the aforementioned reasons.

**III. Rejection of Claims 11-12, 19, 41-42, 48, 50, and 56-59 under 35 U.S.C. § 103(a)**

Claims 11-12, 19, 41-42, 48, 50, and 56-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,216,141 to Straub et al. ("Straub et al."), PCT Patent No. WO 00/48069 to Cho Jun Ho et al. ("Cho Jun Ho et al."), and U.S. Patent No. 6,340,977 to Lui et al. ("Lui et al."). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The arguments made above make plain that the combination of Straub et al. and Cho Jun Ho et al. do not disclose, or even suggest, all of the limitations of Claim 1, upon which Claims 11-12 depend; Claim 17, upon which claim 19 depends; Claim 31, upon which Claims 41-42 and 56-59 ultimately depend; and Claim 47, upon which Claims 48 and 50 depend. Lui et al. are not relied upon for disclosing or suggesting

the limitations of Claims 1, 17, 31, and 47 not disclosed by the combination of Straub et al. and Cho Jun Ho et al. It is therefore respectfully submitted that the combination of Straub et al., Cho Jun Ho et al., and Lui et al. does not render unpatentable Claims 11-12, 19, 41-42, 48, 50, and 56-59.

**IV. Rejection of Claims 4, 16, 34, and 46 under 35 U.S.C. § 103(a)**

Claims 4, 16, 34, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,216,141 to Straub et al. ("Straub et al."), PCT Patent No. WO 00/48069 to Cho Jun Ho et al. ("Cho Jun Ho et al."), and U.S. Patent No. 6,643,652 to Hegeson et al. ("Hegeson et al."). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The arguments made above make plain that the combination of Straub et al. and Cho Jun Ho et al. do not disclose, or even suggest, all of the limitations of Claim 1, upon which Claims 4 and 16 ultimately depend, and Claim 31, upon which Claims 34 and 46 ultimately depend. Hegeson et al. are not relied upon for disclosing or suggesting the limitations of Claims 1 and 31 not disclosed by the combination of Straub et al. and Cho Jun Ho et al. It is therefore respectfully submitted that the combination of Straub et al., Cho Jun Ho et al., and Hegeson et al. does not render unpatentable Claims 4, 16, 34, and 46.

**V. Rejection of Claims 9, 39, and 91 under 35 U.S.C. § 103(a)**

Claims 9, 39, and 91 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,216,141 to Straub et al. ("Straub et al."), PCT Patent No. WO 00/48069 to Cho Jun Ho et al. ("Cho Jun Ho et al."), and U.S. Patent No. 6,452,609 to Katinsky et al. ("Katinsky et al."). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*,

490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The arguments made above make plain that the combination of Straub et al. and Cho Jun Ho et al. do not disclose, or even suggest, all of the limitations of Claim 1, upon which Claim 9 depends; Claim 31, upon which Claim 39 depends; and Claim 85, upon which Claim 91 depends. Katinsky et al. are not relied upon for disclosing or suggesting the limitations of Claims 1, 31, and 85 not disclosed by the combination of Straub et al. and Cho Jun Ho et al. It is therefore respectfully submitted that the combination of Straub et al., Cho Jun Ho et al., and Katinsky et al. does not render unpatentable Claims 9, 39, and 91.

**VI. Rejection of Claims 28 and 73 under 35 U.S.C. § 103(a)**

Claims 28 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,216,141 to Straub et al. ("Straub et al."), PCT Patent No. WO 00/48069 to Cho Jun Ho et al. ("Cho Jun Ho et al."), and U.S. Patent No. 6,288,801 to Leberl et al. ("Leberl et al."). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The arguments made above make plain that the combination of Straub et al. and Cho Jun Ho et al. do not disclose, or even suggest, all of the limitations of Claim 1, upon which Claim 28 depends, and Claim 31, upon which Claim 73 depends. Leberl et al. are not relied upon for disclosing or suggesting the limitations of Claims 1 and 31 not disclosed by the combination of Straub et al. and Cho Jun Ho et al. It is therefore respectfully submitted that the combination of Straub et al., Cho Jun Ho et al., and Leberl et al. does not render unpatentable Claims 28 and 73.

**VII. Rejection of Claims 30 and 93-98 under 35 U.S.C. § 103(a)**

Claims 30 and 93-98 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,216,141 to Straub et al. ("Straub et al."), PCT Patent No. WO 00/48069 to Cho Jun Ho et al. ("Cho Jun Ho et al."), and U.S. Patent No. 5,990,905 to Chew et al. ("Chew

et al.”). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The arguments made above make plain that the combination of Straub et al. and Cho Jun Ho et al. do not substantially disclose, or even suggest, the limitations of Claims 93-96; Claim 97, upon which Claim 98 depends; and Claim 1, upon which Claim 30 depends. Chew et al. are not relied upon for disclosing or suggesting the limitations of Claims 1 and 93-97 not disclosed by the combination of Straub et al. and Cho Jun Ho et al. It is therefore respectfully submitted that the combination of Straub et al., Cho Jun Ho et al., and Chew et al. does not render unpatentable Claims 30 and 93-98.

### **CONCLUSION**

Applicants respectfully submit that all pending claims of the present application are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

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Respectfully submitted,

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